Claims 1-2, 5-6, 8-11, 14-15, 18-22 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,822,775, hereinafter referred to as Hidary. In summary, the Examiner regarded Hidary as disclosing a method of advertising identical to the method recited in the above referenced claims.

Claims 3-4,12-13 were rejected under 35 U.S.C. 103(a) as being obvious based on Hidary in view of WO 97/37500, hereinafter referred to as Titmuss. In summary, the Examiner used Titmuss for disclosing a GPS enabled telephone and that one skilled in the arts would have combined the teachings of Hidary to reach the method recited in the above referenced claims.

Claims 7 and 16-17 were rejected under 35 U.S.C. 103(a) as being obvious based on Hidary in view of U.S. Patent No. 5,673,332 (Pepe et al.) and WO/98/34189 (Roth). In summary, the Examiner found that Pepe et al. discloses the use of wireless electronic devices capable of making Internet connections and that Roth discloses that the use of targeting ads based on the user activities when connected to the Internet is old and that the use of cookies for targeting is old. Therefore, one trained in the art would have combined Hidary, Pepe et at. and Roth to reach the invention recited in the above referenced claims.

In response, Claims 2, 5, 6, 10-12, 15, 18 and 20-22 have been cancelled. Claim 1 has been amended to include the limitation originally cited in Claims 5 and 6. Claims 3, 7, 13, 15, and 17 have changed their dependency to Claim 1. Claims 4, 13, 16 have been amended to more clearly define the invention. Reconsideration of Claims 1-4, 7-9, 14, 16, 17, and 19 are hereby requested.

More specifically, Claim 1 has been amended as follows:

1.      A method of marketing to a [users] user of an electronic device connected via a

1    wireless connection to a <u>computer</u> wide area network, comprising the following steps:

2          a. [identifying] <u>selecting</u> an electronic device [connected] <u>used to connect</u> to [a] said

3    <u>computer</u> wide area network;

4          <u>b.  selecting a server connected to said computer wide area network;</u>

5          [b] <u>c</u>. determining the physical location of said electronic device when connected to

6    said <u>computer</u> wide area network;

7          <u>d. determining the network identity and the network connection activities of said</u>

8    <u>electronic device when connected to said computer wide area network;</u>

9          [c.] <u>e</u>. creating a user file containing [the] <u>said network</u> identity <u>of said electronic</u>

10   <u>device,</u> [and] <u>said</u> physical location information of said electronic device[;]<u>, and said network</u>

11   <u>connection activities of said electronic device when connected to said computer wide area</u>

12   <u>network;</u>

13         [d.] <u>f</u>. selecting advertising material to be sent to said electronic device; and

14         [e.] <u>g</u>. transmitting said advertising material to said electronic device over said

15   <u>computer</u> wide area network using [the identity and physical location in] said user file.

16         In summary, the language in Claim 5 which recites a server connected to the

17   computer wide area network, has been added to Claim1 (see element b). Claim 6 which

18   recited the step of determining the network connection activity of the electronic device has

19   also been added (new element c) to Claim 1.   Also, the term "wide area network" has been

20   further defined as a "computer wide area network" throughout the independent Claim 1 and

21   the dependent claims.  In element (e), the user file is stated as containing the network identity

22   of the electronic device, the physical location information of the electronic device, and <u>the</u>

23   <u>network connection activities</u> to improve readability.   The network connection activities

1  language (underlined) was originally cited in Claim 10 (now cancelled).  No new matter is

2  being raised by this Amendment.

3       Reconsideration is now requested for the following reasons:

4       A.  The method recited in Claim 1 is not anticipated by the cited References.

5       Applicant's invention is designed to continuously or intermittently transmit

6  advertisements to users located in their motor vehicles traveling in a region serviced by a

7  wireless telephone system.  Because the electronic device is located in a motor vehicle, it is

8  likely to be "turned on" at all times when the motor vehicle is operated, the Applicant had to

9  conceive of a way to constantly communicate with the computer at all times while the motor

10  vehicle is moving. This is accomplished by using an electronic device, a wireless telephone

11  network, a computer wide area network, and a server that identifies the network address of

12  the electronic device, determines the precise physical location of the electronic device at all

13  times when connected to the wide area network, and the network connection activities.  All

14  of this information is then used to selects advertisements for transmission to the electronic

15  device over the networks.

16       The electronic device may be a PDA, a laptop computer or a motor vehicle-mounted

17  computer, coupled to a wireless telephone or modem that communicates with a local wireless

18  telephone network.  In the preferred embodiment, each electronic device is connected to a

19  GPS receiver that continuously determines the precise location of the electronic device.

20  During operation, the server collects information regarding the network identity of the

21  electronic device (and possibly the user), the current physical location of the electronic

22  device, and the past or current network connection activities to create a user file.  Using the

23  information in the user file, the server then selects advertisements which may be constantly

1    or intermittently transmitted to the electronic device as it travels through the service area of

2    the wireless telephone network.   Since the electronic device is constantly connected to the

3    wide area network, the server may select different advertisements to continuously download

4    to and from the electronic device as it moves throughout the region.

5          Hidary discloses a very narrow cellular telephone based advertising system used to

6    reduce the cost of cellular telephone service by charging companies for audio advertisements

7    played to callers. The system delivers 1 to 30 seconds of specific or general audio

8    advertisements to cellular telephone callers and/or to their receiving parties.  The types of

9    audio advertisements played are determined by the caller's profile and the cell location used

10   when the caller initially places the call.  No discussion or suggestion is made by Hidary

11   regarding callers that move between cells when placing a cellular telephone.   The only

12   "monitoring" act performed by Hidary's system is to determine whether the cellular

13   telephone number, the location of the cell used to place the call, and whether the cellular

14   telephone call is an emergency "911" call.  This monitoring is not used to determine the type

15   of advertisement to played to the caller but instead used to determine whether any

16   advertisement should be played.  The Applicant submits this type of "monitoring" is now

17   more clearly stated in Claim 1.

18         For all of the above reasons, the Applicant submits that the invention now recited in

19   Claim 1 is not anticipated by Hidary.

20         B.  The method in Claim 1 provides unexpected benefits that support a find of non-

21   obvious.

22         The Applicant submits that none of the cited prior art references disclose or suggest a

23   method of advertising that uses an electronic device that communicates with a wireless

communication network and a computer wide area network with a server that uses the

identification, physical location, and network activity information to select and transmit

advertisements to the electronic device as it moves.   As mentioned above, such a method can

be used to continuously transmit advertisements to users traveling in a region.

Key features of the invention are the use of a server that uses monitors the network

connection activities and the physical location of the of the electronic device to select

advertisements.   None of the cited references disclose or suggest a method that used these

two combined features. In Hidary, the types of advertisements played to users are selected by

reviewing the cell location and the user's profile which contains personal user information,

such as age, gender, occupation, tastes, etc.  In Applicant's invention, the types of

advertisements selected to be downloaded to the user are based on the network identification

of the user, the physical location of the user (not the cell region), and the network activities

of the user.   The personal information of the user is an optional feature and may added if

desired.  If Hidary, personal information is a required feature.   Because the physical

location of the electronic device enables the server to track the electronic device throughout

the wireless telephone region it may be used continuously.   If the location was determined

by the cell location where the initial wireless call was connected,  any communication

between the electronic device and the server would be discontinued when the user moved to

another cell.   Another important feature is that by using past or current network connection

activities information, the user's true interest may be determined and  advertisements can be
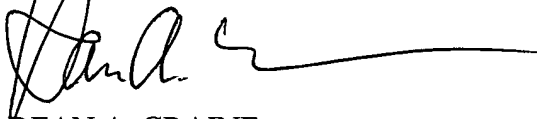
more accurately targeted.

Contrary to the Examiners' statements, Titmuss does not disclose a GPS enabled

telephone.  Instead, it discusses in the prior art different types of cellular telephone formats

1  including those conforming to a GSM standard.  A GSM standard telephone is not a GPS

2  enabled telephone. Even if a prior art reference could found that disclosed a GPS enabled

3  telephone,  it would teach using the GPS information to select advertisements to be

4  transmitted to the user over wide area and wireless networks.  Hidary does not disclose or

5  suggest the use of GPS enabled telephones because the call is not likely to move outside the

6  cell region while the initial telephone call is placed and during the 1 to 30 second period the

7  message is player.

8      Regarding Pepe et. al. and Roth, the Applicant is not contending that he invented a

9  WEB-enabled telephone or the idea of transmitting advertisements over the WEB to users

10  based on their network activities. He does contend however, that he is the first to combine

11  both of these features along with the use of an electronic device that communicates with the

12  WEB via a wireless telephone network and the use of a server that selects advertisements

13  based on a user file container identity information, location information, and network activity

14  information.

15      For  all of the above stated reasons, Notice of Allowance should be granted.

16  Respectfully submitted,

17

18  DEAN A. CRAINE

19  Reg. No. 33,591

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

# CLAIMS

I claim:

1.      A method of marketing to a [users] user of an electronic device connected via a wireless connection to a computer wide area network, comprising the following steps:

      a. [identifying] selecting an electronic device used to connect [connected] to [a] said computer wide area network;

      b. selecting a server connected to said computer wide area network;

      [b] c. determining the network identity physical location of said electronic device when connected to said computer wide area network;

      [c] d. determining the network identity and said network connection activities of said electronic device when connected to said computer wide area network;

      [c.] e. creating a user file containing [the] said network identity of said electronic device, [and] physical location information of said electronic device[;], and said network connection activities of said electronic device when connected to said computer wide area network;

      [d.] f. selecting advertising material to be sent to said electronic device; and

      [e.] g. transmitting said advertising material to said electronic device over said computer wide area network using [the identity and physical location in] said user file.


3.      A method of marketing, as recited in Claim [2] 1, wherein the step (b) of determining the physical location of said electronic device is accomplished using a global positioning satellite system which provides global coordinate information of said electronic device when connected to said wide area network.

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2    4.    A method of marketing, as recited in Claim 1, wherein said step (b) is carried out by

3    a wireless modem connected to said electronic device and [a cellular] used to communicate

4    with said wireless telephone [system] network, said wireless telephone network capable of

5    determining the physical location of said wireless modem [used to connect said electronic

6    device] when connected to said wireless telephone network and moving throughout the

7    region served by said wireless telephone network

8

9    7.    A method of marketing, as reciting in Claim [6] 1, wherein the step (c) of

10   determining the network connection activities of said electronic device is carried out by

11   determining the existence of "cookies" on said electronic device.

12

13   13.    A method of advertising as recited in Claim [12] 1 wherein step [(d)] (c) is carried

14   out using information transmitted by said electronic device when connected to said computer

15   wide area network.

16

17   14.    A method of marketing, as recited in Claim [11] 1, wherein said step (c) is carried

18   out by a cellular telephone system capable of determining the physical location of a cellular

19   telephone used to connect to said wide area network.

20

21   16.    A method of marketing, as recited in Claim 15, wherein said step (a) of identifying

22   said electronic device is accomplished by determining the numerical network address

23   assigned to said electronic device [by said server].

13

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17.     A method of marketing, as recited in Claim [11] <u>1</u>, wherein said step [(a)] <u>(c)</u> of

<u>determining the network identity of</u> [identifying] said electronic device is accomplished using

client software <u>loaded into said electronic</u> device to transmit [identification] <u>said</u> information

to said server.

19.     A method of marketing, as recited in Claim [15] <u>1</u>, wherein said <u>step (d) said</u> server

collects personal data of said user of said electronic device and adds it to said user file.

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